

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed September 2, 2009. The Office Action has continued to reject all examined claims. In response, Applicant submits the foregoing amendments and the following remarks.

#### **Response to Claim Rejections under 35 U.S.C. 101**

The Office Action (pages 2 and 5) states that claims 1, 4 and 5 are directed to non-statutory subject matter. The Office Action states that the claim language does not include a required tie or transformation. Applicant has further amended claims 1, 4, and 5 so as to overcome the rejections under U.S.C. 101.

The amended claims 1, 4 and 5 specify 'a customer interface' and 'a controller computer' in the body of the claim. The customer interface and controller computer are functionally involved in the method steps. Accordingly, the method specified in claims 1, 4 and 5 is considered a "process" under U.S.C. 101.

For at least these reasons, the rejections under U.S.C. 101 should be withdrawn.

Applicant does, however, traverse the continued rejection of these claims. The Office Action disregarded Applicant's previous amendments to the claims, which tied the claims to a statutory class of invention, on the basis that the amendment only affected the preamble. The Office Action went on to note that preambles are generally not accorded any patentable weight. In support of this position, the Office Action cited two cases (one that is 35 years old, and the other that is over a half century old). Applicant notes that the law has evolved since the decisions of these cases. For

example, the very first sentence of MPEP 2111.02 states: "The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim." *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). MPEP 2111.02 goes on to state that: "If the claim preamble, when read in the context of the entire claim, ... is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). In this particular application, the fact that the preamble specifies that the method is "computer-implemented" does, in fact, give life, meaning, and vitality to the rest of the claim. As such, this feature of the preamble cannot be ignored. If, however, the Examiner maintains that the language of the preamble is non-limiting on this claim, then Applicant will hereafter amend claim 1 to recite a preamble of only: "A method."

As noted above, however, claim 1 has been further amended herein to clearly define over the rejections under 35 U.S.C. § 101. Accordingly, these rejections should be withdrawn.

### **Response to Rejections under 35 U.S.C. § 112**

The Office Action (pages 2~3 and 6~7) rejected claims 16-21 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Applicant has cancelled claims 16~21 in response to this rejection, and therefore the rejections have been rendered moot.

### Response to Rejections under 35 U.S.C. 103

Claims 1, 6, 9, 11, and 14 are rejected under U.S.C. 103(a) as allegedly being unpatentable over Singh et al. (US Patent. No. 7,080,026) in view of Kennedy (US Patent. No. 6,188,989) and Official Notice. Claims 5, 10 and 15 are rejected under U.S.C. 103(a) as being unpatentable over Singh in view of Kennedy and Official Notice and in further view of Boarders et al (US Patent. No. 7,139,721). Claims 16~21 are rejected under U.S.C. 103(a) as being unpatentable over Singh in view of Kennedy and Official Notice and in further view of Shekar et al (US Publication 2003/0208392).

Among these rejected claims, claims 1, 6, and 11 are independent claims. Claims 6 and 11 are rejected on the same basis as claim 1. Therefore, remarks are provided with regard to the patentability of the independent claim 1.

Claim 1 recites:

1. A computer-implemented method for **capacity reservation based on historical customer delivery data**, comprising the steps of:  
a customer interface acquiring historical customer delivery data of a plurality of customers, wherein the historical customer delivery data comprises delivery time requirements corresponding to each customer, wherein the delivery time requirements comprise requirements selected from the group consisting of fixed delivery time requirements, distributed delivery time requirements, and floating delivery time requirements;  
a controller computer classifying the customers into a plurality of different categories according to the historical customer delivery data; and  
the controller **computer further reserving production capacity for the customers in accordance with the different categories.**

*(Emphasis Added).* Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

In order for a claim to be properly rejected under 35 U.S.C. §103(a), the teachings of the prior art reference must suggest all features of the claimed invention to

one of ordinary skill in the art. The controlling legal precedent for the determination of obviousness is the recent decision by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 1, 82 USPQ2d 1385 (2007). See MPEP § 2141. Even in light of the KSR decision, an obviousness rejection is not proper if it relies on a modification of a prior art reference that would change the principle of operation of the prior art invention. MPEP § 2143.01 subsection VI.

First, neither Singh nor Kennedy discloses features pertaining to 'capacity reservation'.

The 'supply chain demand forecasting and planning' of Singh describes systems and methods for proactively predicting demand (Singh, col. 1, lines 14~19). Since the invention of Singh is implemented to proactively predict demand, it is clear that the invention of Singh is implemented before a customer actually submits an order.

On the contrary, claim 1 defines a method for capacity reservation based on historical customer delivery data. It is common sense for one of ordinary skill in the art that 'capacity reservation' implements after a customer actually submits an order. Accordingly, the demand prediction of Singh is completely different from the 'capacity reservation' of claim 1. For at least this reason, the rejection of claim 1 should be withdrawn.

In addition, Kennedy describes a 'system and method for managing available to promised product'.

On the contrary, claim 1 defines a method for capacity reservation based on historical customer delivery data. It is common sense for one of ordinary skill in the art

that 'capacity reservation' is completely different from 'managing available to promised product' of Kennedy.

For at least the foregoing reasons, neither Singh nor Kennedy discloses features pertaining to 'capacity reservation,' as specifically recited in claim 1, and the rejection of claim 1 should be withdrawn.

The Office Action states that Singh teaches using shipment data for capacity reservation; Kennedy teaches reserving production capacity for the customers in accordance with the different categories; and fixed, floating, and distributed delivery time requirement types are well known. In addition, the Office Action states that the claimed invention can be obtained from combination of the cited features.

Applicant respectfully disagrees, and believes that the Examiner does not have a thorough understanding of the claimed invention and/or the cited references.

First, Singh teaches using shipment data for demand forecasting, rather than for capacity reservation.

Second, Kennedy teaches reserving available to promise product, rather than reserving production capacity for the customers. In addition, Kennedy implements the reservation in accordance with a hierarchy of seller entities.

Based on the disclosures of Singh, Kennedy, and the Examiner's statement of Official Notice, the combination of the cited references is as follows: using shipment data for demand forecasting, reserving available to promise product in accordance with a hierarchy of seller entities, wherein the shipment data may comprise fixed, floating, and distributed delivery time requirement types.

To one of ordinary skill in the art, the computer-implemented method for capacity reservation based on historical customer delivery data cannot be obtained from the combination.

For at least the foregoing reasons, teachings of Singh, Kennedy, and the so-called 'old and well known art' do not suggest all features of the claim 1 to one of ordinary skill in the art. The proposed modification of the applied references CANNOT achieve the claimed subject matter. That is, even if the references could be properly combined, the resulting combination still fails to disclose all features of claim 1. Accordingly, the rejection of claim 1 should be withdrawn.

On the same basis as claim 1, the rejections of independent claims 6 and 11 should be withdrawn. Insofar as all remaining claims depend from claim 1, claim 6, or claim 11, all remaining rejections should be withdrawn for the same reasons. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

As a separate and independent basis for the patentability of all claims, Applicant submits that the combination of Singh and Kennedy is improper and therefore does not render the claims obvious. In this regard, the Office Action combined Kennedy with Singh to reject the claims on the solely expressed basis that "it would have been obvious ... since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable." (see e.g., Office Action, p. 8)

This rationale is both incomplete and improper in view of the established standards for rejections under 35 U.S.C. § 103.

In this regard, the MPEP section 2141 states:

The Supreme Court in KSR reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966))... As reiterated by the Supreme Court in KSR, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (A) Ascertaining the differences between the claimed invention and the prior art; and
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

In addition:

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

As reflected above, the foregoing approach to obviousness determinations was recently confirmed by the United States Supreme Court decision in KSR INTERNATIONAL CO. V. TELEFLEX INC. ET AL. 550 U.S. 1, 82 USPQ2d 1385, 1395-97 (2007), where the Court stated:

In *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1 (1966), the Court set out a framework for applying the statutory language of §103,

language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and its progeny. See 383 U. S., at 15–17. The analysis is objective:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.*, at 17–18.

Indeed, as now expressly embodied in MPEP 2143, “[t]he **key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious**. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (*Emphasis added, MPEP 2143*). “Objective evidence relevant to the issue of obviousness **must** be evaluated by Office personnel.” (MPEP 2141). “The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (MPEP 2141).

Simply stated, the Office Action has failed to at least (1) ascertain the differences between and prior art and the claims in issue; and (2) resolve the level of ordinary skill in the art. Furthermore, the alleged rationale for combining the references is merely an improper conclusory statement that embodies clear and improper hindsight rationale.



As reflected above, the Office Action alleged that the combination of Kennedy with Singh would have been obvious "since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable." However, no objective evidence was offered by the Examiner to support the allegation that the results of the combination would have been predictable. Further, it is axiomatic in the patent law that every patent claim is merely a novel combination of well known features. Therefore, merely alleging the claimed elements were individually well known does not satisfy the Examiner's legal burden for articulating a proper motivation to combine the references.

For at least these additional reasons, Applicant submits that the rejections of all claims are improper and should be withdrawn.

### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings

of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this submission. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account 20-0778.

Respectfully submitted,

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